

Remarks

Claims 1-22 stand rejected. Claim 6 is cancelled. Claims 2, 5, and 14-22 have been amended and/ or renumbered. Specifically, it is noted that claim 13 has been amended to change "pieces" to "cards" to conform to the specification. The specification has been amended as set forth in the attached substitute specification to correct a typo on page 19, line 24 to add the term "will" and to conform the specification to the parent application serial number 09/327,855 to overcome inadvertent scanning errors. No new matter is presented as a result of the substitute specification as the amendment relies upon the incorporation by reference in Form sb0005 filed on October 30, 2003. In view of the above amendments and remarks set forth below, reconsideration is respectfully requested. No new matter has been entered as a result of this response.

**I. Examiner Interview on December 13, 2003:**

A telephonic interview was conducted on April 22, 2003 between the undersigned and Examiner Brockett in which claim 1-22 were discussed. The substance of the interview has been prepared by Examiner Brockett and is reproduced with typo corrections as follows:

The Examiner notes that in claim 1 the limitation of "an identifier for the number of bingo cards in play" is not present in Birenbaum. Birenbaum does not clearly state that an identifier is used to track the number of cards in play. The Examiner will conduct a new search on this limitation once Applicant files his amendment. With respect to claim 2 the Examiner noted that the broad claim language reads on Birenbaum, in that Birenbaum has the processor select a bingo card for display as the card closest to winning. Applicant will submit arguments that software is structural and the Examiner will take these arguments into consideration when preparing the next office action. The Examiner will reconsider the language including "adapted to" as being structurally limiting. Applicant intends to submit a substitute specification based on missing paragraphs and equations that were not properly scanned into the application.

Applicant generally agrees with the Examiner's statement and thanks the Examiner for the interview time and preparation of the interview summary. However, the phrase "the

language including "adapted to" as being structurally limiting" is not entirely consistent with the conversation. Reconsideration of "adapted to" language was requested as MPEP 2106 when referring to language that limits a claim's scope does state that this term when used in a claim "per se" does not limit a claim to a particular structure, but "may raise a question" thus requiring further consideration by the Examiner. Reconsideration of the Examiner's rejection on "adapted to" language is requested in view of this difference, as the Office Action analysis appears to interpret the term "adapted to" as a "per se" instance when a phrase is not limiting. Except for claim 1 which was copied from the parent to this application in which all claims allowed in the parent included "adapted to" language, claims 2, 5, 14, and 17-20 have been amended to delete the adapted to language. These amendments are intended to facilitate examination of the claims on their merits and are not intended to limit the claims.

**II. Rejection Under Double Patenting:**

Claims 1, 2 and 18 have been rejected under the judicially created doctrine of double patenting. Applicant recognizes that a terminal disclaimer may be filed to overcome this rejection; however, Applicant reserves the filing of a Terminal Disclaimer until such time that the claims are otherwise in condition for allowance as this reject may be rendered moot by amendments during prosecution.

**III. Rejection Under 35 USC § 102:**

Claims 1-8 and 18-22 have been rejected as being anticipated by Birenbaum et al., US Patent No. 4,768,151 (Birenbaum). It is noted that the rejection of claim 1 has been withdrawn per the Interview Summary recited above. Furthermore, reconsideration of claim 5 should be made for the same reasons.

With regard to the remainder of the claim rejections as being anticipated by Birenbaum, it is noted that the Examiner's analysis relies in part upon a false proposition that software merely

reflects an intended use of hardware and is not itself patentable. Applicant notes that it has been more than 10 years since the Federal Circuit directed the US Patent and Trademark Office (USPTO) to recognize software as patentable structure in a computer-related invention. It took the USPTO two years from that mandate to develop Guidelines for the Examination of Computer- Related Inventions first published in 1996. A current updated version of these Guidelines that reflects subsequent Federal Circuit decisions is set forth in the current version of MPEP 2106. Nevertheless, a request has been made to “ submit arguments that software is structural.”

It should be noted that the Office Action anticipation analysis set forth on the last paragraph of page 6 through the first paragraph of page 8 incorrectly relies upon case law and legal holdings that are no longer valid legal holdings for software cases. In In re Alappat, 31 USPQ2d 1545 (1994), the Federal Circuit specifically directed the US Patent and Trademark Office to abandon reliance on such case law in order to make patent examination in software technology consistent with the US Supreme Court’s position on statutory subject matter rendered in Diamond v. Diehr, 450 U.S. 175 (1981). In 1996 the USPTO came out with its first draft of Guidelines for the Examination of Computer- Related Inventions in which the USPTO concisely set forth the legal standards that Examiners and the public could use for determining patentability of software. As stated above, a version of the Guidelines is set forth in MPEP 2106.

Nevertheless, the present anticipation analysis seems rely upon the false legal theory that software is merely an unpatentable intended use of hardware. The case law relied upon in the Office Action to make this assertion, namely, Ex parte Masham, In re Casey, In re Otto, and Hewlett-Packard Co. v. Baush & Lomb Inc., are all before In Re Alappat and are not cited in MPEP 2106. Compounding the confusion is a reference to MPEP 2106 relating to “adapted to”

language that is misapplied to further support this analysis that software is an unpatentable intended use of hardware.

Applicant points out that the section of MPEP 2106 that relates to 102 and 103 rejections at VI. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 102 AND 103 requires the opposite result from the analysis recited on pages 6-8 of the Office Action, namely, that the Examiner consider that “[f]unctional descriptive material is a limitation in the claim.”

Compounding the confusion of the claim rejections in view of Birenbaum is the analysis, when applied to “functional descriptive material” in the claims, does not appear to be analyzed consistently with either MPEP 2106 or the false legal analysis produced on pages 6-8 of the Office Action, given that some “functional descriptive material” that appears similar to functions in Birenbaum are relied in making the anticipation rejection while other “functional descriptive material” not at all found in Birenbaum are dismissed as being an unpatentable “intended use” of the hardware.

Given that the anticipation analysis is based off of a false legal holding that is opposite to the approach for reviewing computer-related inventions in MPEP 2106, part VI, and that the analysis is inconsistent in applying the false legal holding. Applicant requests that the Examiner reconsider the rejection based upon Birenbaum or restate the applicability of Birenbaum in a manner consistent with the examination requirements of MPEP 2106. These remarks are not intended to reflect negatively upon the Examiner as it is understood that failure to fully use and understand the guidelines in MPEP 2106 may be due to a failure of adequate Examiner training by the USPTO and should rather be brought to the attention of the Patent Commissioner.

Thus, for example, in the rejection of claim 2 as being anticipated by Birenbaum it was stated that “With respect to claim 2, the Examiner noted that the broad claim language reads on

Birenbaum, in that Birenbaum has the processor select a bingo card for display as the card closest to winning.” However, such broad language did not consider all of the “functional descriptive material” and other features in claim 2. Birenbaum is limited to selecting cards from permanent memory 52 with help of a user to apparently store them in non-permanent memory 46– see method steps 5 and 6 at col. 3, lines 60-64 of Birenbaum. Nowhere does Birenbaum teach or suggest all the features of claim 2 broadly summed here as selecting at least one card from a plurality of bingo cards in permanent memory independent of the user. Selecting “a card closest to winning for display” is performed well after the user has selected the card from memory 52 at step 5. Similarly, in claim 7, which depends from claim 2, if the ROM 52 found in module 14 corresponds to the memory featured in claim 2, then memory 52 of module 14 cannot also be used to reject another memory in claim 7. Accordingly, reconsideration and withdrawal of the rejection of claims 2 and 7 in view of Birenbaum is respectfully requested. The rejections of claims 1-6, 15 and 18-22 all appear to have ignored “functional descriptive material” to maintain the rejection. Reconsideration and withdraw of these rejections is requested. Alternatively, Applicant requests an explanation of the rejection of Birenbaum that is consistent with MPEP 2106 as the rejection as presently stated is not understood in view MPEP 2106.

**IV. Rejection Under 35 USC § 103:**

All of the rejections under 35 USC 103 continue to rely upon Birenbaum and the false analysis of Birenbaum discussed above. Reconsideration and withdrawal in view of MPEP 2106 is respectfully requested for the reasons stated above.

With regard to the rejection of claims 9 and 10 the rejection would appear to include a modification of Birenbaum in view of applicant’s own invention as the Office Action reconfigures Birenbaum to include a removable memory with the features of claims 9 and 10 relying solely upon applicant’s own invention for the modification. Similarly the rejection of

claims 12 and 13 are also improper for this reason. Applicants request that the examiner present a reference with the features of claims 9 and 10 and 12 and 13 or withdraw the rejection.

With regard to the rejection of claims 11-17 as being unpatentable in view of Fisher et al., US Patent No. 4,480,180, all claims depend from claim 11. Claim 11 features a release key for removing the cartridge. Fisher discloses a release key for use, not in a game device, but in an unrelated credit card and security card device. There is no teaching or suggestion in either Birenbaum or Fisher that would cause anyone to consider a modification of Birenbaum with a credit card or security card device let alone to include the key limitation found in the security device of Fisher. It would appear that the teaching or suggestion for this modification was improperly derived from applicant's own invention. Accordingly, withdraw of the rejection of claim 11 is requested for this reason alone. In fact, the module 14 of Birenbaum relates to multiple modules in which the user selects modules appropriate to the paper cards purchased – see col. 3, lines 52-54. Adding a key to Birenbaum makes no sense as it would frustrate or render impossible the user's need to insert a memory module appropriate to the cards purchased. A modification is improper if it defeats and intended use of the invention. For this reason alone the rejection of claim 11 is improper.

Furthermore, Applicant could not find the features of claims 14-17 supposedly shown in Fig. 1. Notably, nowhere in Birenbaum is the term “stackable” used as in claim 14 rather the apparent fixed handle 20 (Fig. 1) would render the device non-stackable, nowhere in Birenbaum is a ridge and recess combination disclosed as in claim 15, nowhere in Birenbaum is an adjustable handle disclosed as in claim 16 and 17.

For all of these reasons the rejections of claims 14-17 are improper. Reconsideration and withdraw is respectfully requested.

**V. Summary:**

Applicant believes that all the Examiner's rejections have been addressed and overcome. None of the references, either alone, or in combination, anticipate or render obvious the invention claimed in claims 1-5 and 7-22. Accordingly, allowance of the presently pending claims is respectfully requested.

Respectfully submitted,

By: 

Donald J. Cox, Jr.  
Attorney for Applicant  
PTO Reg. No. 37,804

Law Offices of Donald Cox, LLC  
40 Nassau Street  
Princeton, NJ 08542  
(609) 921-1166  
(609) 921-8131 – facsimile